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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,353	06/09/2006	Hiroaki Zaima	0033-1083PUS1	4904

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EXAMINER

GOOD JOHNSON, MOTILEWA

ART UNIT	PAPER NUMBER
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2628

NOTIFICATION DATE	DELIVERY MODE
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07/02/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/582,353	Applicant(s) ZAIMA ET AL.	
	Examiner M GOOD JOHNSON	Art Unit 2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/09/06, 05/10/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 35 and 36 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

Claims 35 and 36, are directed a portable communication terminal, however the claims are dependent upon independent claim 33, which is directed to a data converter.

Claims 35 and 36 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Double Patenting

3. Applicant is advised that should claims 37-42 be found allowable, claims 43-48 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing

one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 43-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 43 recite in lines 6-7, "said first second data format and said file in said second data format". It is unclear whether applicant intends the claim is the first data format or the second data format.

6. Claims 49-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 49, lines 8-11, recite the limitation "data represented in said first and said data formats that are generated as said data are converted; and transmitting said data represented in said first and said data formats that are generated by conversion of said data.", however the claim recited that the data is converted into a first

predetermined data format and a second predetermined data format, therefore it is unclear as whether "said data", is representing the original data, first predetermined data format, or second predetermined data format.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 33-35, 37, 38, 40, 41, 43, 44, 46-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishimura, U.S. Patent Publication 2002/0051181 A1.

Regarding claim 33, Nishimura discloses a data converter comprising: a reception portion receiving electronic mail (paragraph 0045); a conversion portion converting data included in a file attached to said electronic mail, said conversion portion including a first conversion portion converting said data included in said file attached to said electronic mail into data represented in a first predetermined data format (paragraph 0150, GIF format, which Examiner interprets as first predetermined format), and a second conversion portion converting said data included in said file attached to said electronic mail into data represented in a second predetermined data format (paragraph 0151, PNG format, which Examiner interprets as second predetermined format); a memory portion storing said data generated through conversion and represented in said first data format and said data generated through

conversion and represented in said second data format (paragraph 0143); and a transmission portion transmitting said data output from said first and second conversion portions (paragraph 0094).

Regarding claim 34, Nishimura discloses data represented in said first data format includes data representing a list of said converted file or said data generated through conversion; said data represented in said second data format is an image generated by conversion of said file; and said memory portion stores said list and said image in association with each other (figures 8-9, paragraphs 0116-0121).

Regarding claim 35, Nishimura discloses a first display portion receiving said data represented in said first data format to display said list of said file (figure 8, 230); a select portion selecting at least one file from said list of said displayed file (figure 8, 241); a notification portion notifying said data converter of said file selected by said select portion (figure 9, profile selection setting for confirmation, which Examiner interprets as notification); and a second display portion receiving said data represented in said second data format that corresponds to said file that said notification portion notifies said data converter of to display an image (figures 9-11).

Regarding claims 37, 38, 40, 41, 43, 44, 46, 47 and 49-51, they are rejected based upon similar rational as above claims 33-35.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 36, 39 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura as applied to claims 35, 38, and 44 above, further in view of Doll, U.S. Patent Number 6,226,400 B1.

Regarding claims 36, 39 and 45, Nishimura discloses transmitting/receiving E-mail with a filed attachment, and converting the attached file to a filed format of the receiving terminal to accommodate capability of the reception terminal. Nishimura discloses in figure 13, a default compression ratio and converting the file image with a target image format with a ratio, which Examiner interprets as designating a scaling factor and scaling the image based on a scaling factor of data represented in a second data format.

However, it is noted that Nishimura fails to disclose data format being a vector image format.

Doll discloses raster image data converted into a vector format. Doll further discloses that data represented in raster format require large amounts of storage memory and processing time over a network, col. 1, lines 38-67.

It would have been obvious to one of ordinary skill in the art at the time of the invention of Nishimura to include in the format conversion, the raster to vector format conversion as disclosed by Doll, because vector format requires less storage and processing time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M GOOD JOHNSON whose telephone number is (571)272-7658. The examiner can normally be reached on Monday-Friday 8-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee Tung can be reached on (571) 272-7794. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Motilewa Good-Johnson/
Primary Examiner
Art Unit 2628

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